REMARKS

Applicants respectfully request entry of the above amendments to Claim 24. Claims 16-18 and 24 are pending.

Claim 24 has been amended to more clearly indicate the subject matter of the claim, and to place the claims in condition for allowance and in better form for appeal. The amendments to Claim 24 finds support, for example, in the specification at page 29, lines 25-30; page 30, lines 13-17; and page 32, lines 3-14. In particular, support for the term "lymphocyte" may be found, for example, at page 30, lines 13-15, particularly line 14, and elsewhere in the specification. Support for the phrase "or fragment thereof" may be found, for example, at page 29, line 29 and elsewhere in the specification. No new matter is added by way of the claim amendment.

Claims 16-18 and 24 stand rejected under 35 U.S.C. §112, first paragraph, as allegedly containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the invention was filed, had possession of the claimed invention.

The Examiner has indicated that, for the purposes of this examination, the priority date of the present application was considered as if it were May 8, 1998. The Examiner has requested that applicants point to particular disclosures in the specification that provide written support for the language of the instant claims. As discussed below, Applicants point to particular disclosures in the specifications of the present application and of its parent applications that provide written support for the language of the instant claims. The present claims find support in the parent applications and in the present specification. Thus, Applicants believe that the application is entitled to the benefit of all the earlier filing dates of the parent applications and that the present application is entitled to a priority date of February 7, 1997.

Claim 24 stands rejected under 35 U.S.C. § 102(a)as allegedly anticipated by Spencer et al. (*J. Cell Biol.* **138(4)**:845-860 (1997)) as evidenced by Becker et al.

(*FEBS Lett.* **441(1)**:141-147 (1998)), the Examiner stating that "the effective filing date of the instant claims is May 8, 1998."

Claims 16, 17, and 24 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Sodhi et al., *Biochemistry and Molecular Biology International* **35**:559-565 (1995).

Claims 16-18 and 24 stand rejected under 35 U.S.C. §102(b) as allegedly anticipated by Frackleton et al., *Journal of Biological Chemistry* **259**:7909-7915 (1984).

Claims 16-18 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Spencer et al. in view of Ackerman et al. (*Human Cell* **1**:46-53 (1988),) and Nakamura et al. (*Cell Struct. Funct.* **9(2)**:167-169 (1984)).

Claims 16-18 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly obvious over Database SPTREMBL Accession No. P978144 (May 1, 1997) in view of Ackerman and Nakamura.

Applicants respectfully traverse the rejections to the claims for at least the reasons discussed below.

The Claims for the Benefit of an Earlier Priority Date

The Examiner has not accepted the claim for benefit of the earlier filing date of PCT/US98/01774 filed January 30, 1998, which was given the benefit of the earlier filing date of U.S. Application Serial No. 08/938,830 filed September 29, 1997 (now U.S. Patent No. 6,040,437), which was given the benefit of the earlier filing date of U.S. Provisional Application Serial No. 60/104,589 filed February 7, 1997. As discussed below, the present claims find support in all the parent applications. The specifications of PCT/US98/01774, U.S. Application Serial No. 08/938,830, and U.S. Provisional Application Serial No. 60/104,589 provide support for the subject matter of the instant claims. Support for Claims 16-18 is found in the claims as originally filed, and in the specification at pages 29-34.

Thus, Applicants respectfully submit that the present application should be accorded the benefit of all the filing dates of the parent applications.

Support for the phrase "An antibody derivable from a lymphocyte" may be found, for example, at page 30, lines 13-17 (present application, which has the identical specification of its parent PCT application PCT/US98/01774, and of PCT/US98/01774); page 51, lines 20-25 (U.S. Application Serial No. 08/938,830); and page 59, lines 26-32 (U.S. Provisional Application Serial No. 60/104,589). These specifications also note that antibodies "exhibit binding specificity to a specific antigen" (page 10, line 15, present application; page 17, line 26, U.S. Application Serial No. 08/938,830; page 17, lines 24-25 U.S. Provisional Application Serial No. 60/104,589).

Support for the phrase "or fragment thereof" may be found, for example, at page 29, line 29 (present application and PCT/US98/01774); page 50, line 19; U.S. Application Serial No. 08/938,830; and page 50, line 19; U.S. Provisional Application Serial No. 60/104,589, page 58 lines 17-18.

Support for the phrase "that specifically binds to a PSTPIP polypeptide of SEQ ID NO:1" may be found, for example, at page 10, line 15 (present application and PCT/US98/01774); page 17, line 26, U.S. Application Serial No. 08/938,830; page 17, lines 24-25 U.S. Provisional Application Serial No. 60/104,589.

Support for the phrase "that has been immunized..." maybe found in the present specification, for example, at page 29, lines 25-39 (and at the same pages in PCT/US98/01774); and page 30, lines 1-18; in the specification of U.S. Application Serial No. 08/938,830, for example, at page 50, lines 15-27, page 51, lines 1-25; for example, at page 58, lines 12-31 and page 30, lines 1-18; in the specification of U.S. Application Serial No. 08/938,830, for example, in the specification of U.S. Provisional Application Serial No. 60/104,589, for example, at page 58, lines 12- 31, page 59, lines 1-32, to page 60, lines 1-3.

The present specification and the specifications of the parent applications provide support for the pending claims. Thus, since support for the claimed invention is found in the specifications from which benefit is claimed as well as in the present specification, Applicants respectfully submit that the present application is entitled to the

benefit of all the earlier filing dates of the parent applications and so should be accorded a priority date of February 7, 1997.

The Claim Rejections Under 35 U.S.C. §112, First Paragraph

Claims 16-18 and 24 stand rejected as allegedly introducing new matter, the Examiner characterizing the rejection as "a new matter rejection." Applicants traverse this rejection.

The Examiner requests that "particular disclosures in the specification as originally filed" be pointed out "to provide the necessary written support for the language of the instant claims" (page 3, fourth paragraph, final Office Action). The claims have been amended for clarity; thus, in some cases, the exact phrase objected to by the Examiner is no longer in the claim (*e.g.,* Claim 24 now recites an antibody "derivable from a lymphocyte" and that specifically binds "a PSTPIP polypeptide of SEQ ID NO:1").

The necessary written support for the present claims maybe found, for example, at the pages named above. Discussion regarding antibodies derivable from a lymphocyte maybe found, for example, at pages 30, lines 13-17 (present application and PCT application PCT/US98/01774); page 51, lines 20-25 (U.S. Application Serial No. 08/938,830); and page 59, lines 26-32 (U.S. Provisional Application Serial No. 60/104,589). Support for the claim element "that specifically binds to a PSTPIP polypeptide of SEQ ID NO: 1" may be found, for example, at page 10, line 15, present application; page 17, line 26, U.S. Application Serial No. 08/938,830; page 17, lines 24-25, U.S. Provisional Application Serial No. 60/104,589. The claim element "or fragment thereof" finds support, for example, at page 29, line 29 (present application); page 50, line 19; U.S. Application Serial No. 08/938,830; and page 50, line 19; U.S. Provisional Application Serial No. 60/104,589, page 58 lines 17-18.

Applicants submit that adequate support for the claimed invention is found in the present and parent specifications. Applicants respectfully disagree with the characterization that the antibodies claimed as described in the quoted sections of the

parent and the present specifications are not described by the original disclosure. However, this point is moot, since, with the present amendment, no claim recites "derivable from an antibody-producing cell" nor "an epitope within SEQ ID NO:1."

Accordingly, for at least these reasons, Applicants submit that the rejection to Claims 16-18 and 24 under 35 U.S.C. §112, first paragraph, is overcome.

The Rejection of Claim 24 Under 35 U.S.C. §102(a) over Spencer and Becker

Claim 24 stands rejected under 35 U.S.C. §102(a) as allegedly being anticipated by Spencer et al. (*J. Cell Biol.* **138(4)**:845-860 (August 25, 1997), hereafter "Spencer") as evidenced by Becker et al. (*FEBS Lett.* 441(1):141-147 (1998) hereafter "Becker"). Spencer et al. is presented by the Examiner as discussing an anti-PSTPIP polyclonal antibody. Becker et al. is presented as suggesting that co-expression of an exogenous tyrosine kinase is necessary to produce a soluble recombinant protein in *E. coli* that has a phosphorylated tyrosine. Applicants respectfully traverse this rejection.

The Spencer reference cited against Claim 24 is dated August 25, 1997, which, as discussed above, is after the priority date of February 7, 1997 of the instant application. Thus, Spencer is not a proper reference against the present application. In addition, Becker, dated in 1998 which is also after the priority date of the instant application, is likewise not a proper reference. Accordingly, for this reason at least, applicants respectfully submit that the rejection under 35 U.S.C. §102(a) is overcome.

The Rejection of Claims 16, 17, and 24 Under 35 U.S.C. §102(b) over Sodhi

Claims 16, 17, and 24 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Sodhi et al., *Biochemistry and Molecular Biology International* **35**:559-565 (1995) (hereafter "Sodhi"), the Examiner stating that Sodhi "teaches the use of an anti-phosphotyrosine-FITC antibody, a fluorescently labeled and detectable antibody, to study proteins." It is suggested that the Sodhi antibody will bind specifically to "an epitope contained within the protein of SEQ ID NO: 1."

Anticipation under 35 U.S.C. §102 requires that "every element of the claimed invention be identically shown in a single reference." (*In re Bond*, 910 F.2d 831,832 (Fed. Cir. 1990).

However, Claims 16, 17, and amended 24 do not recite an antibody that will bind specifically to "an epitope contained within the protein of SEQ ID NO: 1." Claims 16, 17, and amended 24 do require, among other elements, that the claimed antibody be "derivable from a lymphocyte from an animal that has been immunized with ... a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof." Applicants submit that Sodhi does not discuss an antibody derivable from a lymphocyte from an animal immunized with a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof. Thus, lacking at least this element of the claimed invention, Sodhi fails to anticipate Claims 16, 17, and 24. Accordingly, Applicants respectfully submit that the rejections of Claims 16, 17, and 24 under 35 U.S.C. §102(b) over Sodhi is overcome.

The Rejection of Claims 16-18 and 24 Under 35 U.S.C. §102(b) over Frackleton

Claims 16-18 and 24 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Frackleton et al., *Journal of Biological Chemistry* **259**:7909-7915 (1984) (hereafter "Frackleton"), the Examiner stating that Frackleton "teaches the use of an anti-phosphotyrosine monoclonal antibody, which is produced by a hybridoma cell line, to isolate proteins." It is suggested that the Frackleton antibody will bind specifically to "an epitope contained within the protein of SEQ ID NO: 1."

However, Claims 16-18 and amended 24 do not recite an antibody that will bind specifically to "an epitope contained within the protein of SEQ ID NO: 1." Claims 16-18, and amended 24 do require, among other elements, that the claimed antibody be "derivable from a lymphocyte from an animal that has been immunized with ... a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof." Applicants submit that Frackleton does not discuss an antibody derivable from a lymphocyte from an animal immunized with a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof. Thus, lacking at least this element of the claimed invention, Frackleton fails to anticipate

Claims 16-18 and 24. Accordingly, Applicants respectfully submit that the rejections of Claims 16-18, and 24 under 35 U.S.C. §102(b) over Frackleton is overcome.

The Claim Rejections Under 35 U.S.C. §103(a) over Spencer, Ackerman and Nakamura

Claims 16-18 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Spencer et al. (*J. Cell Biol.* **138(4)**:845-860 (1997), hereafter "Spencer") in view of Ackerman (*Human Cell* **1**:46-53 (1988), hereafter "Ackerman") and Nakamura et al. (*Cell Struct. Funct.* **9(2)**:167-169 (1984) hereafter "Nakamura").

Applicants respectfully traverse this rejection.

The Spencer reference is dated August 25, 1997, which, as discussed above, is after the priority date of February 7, 1997 of the instant application. Thus, the Spencer reference is not a proper reference against the present claims.

Ackerman is presented to suggest that generating monoclonal antibodies is routine and that monoclonal antibodies provide numerous advantages. Nakamura is presented as suggesting that a monoclonal antibody has more than one utility, including the detection, quantification, and localization of the protein to which the antibody binds. However, each reference individually lacks elements of the claimed invention (*e.g.,* lacks disclosure of an antibody derivable from a lymphocyte from an animal that has been immunized with a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof).

In addition, the combination of Ackerman and Nakamura fail to provide all the elements of the present claims. For example, Ackerman and Nakamura fail to provide an antibody "derivable from a lymphocyte from an animal that has been immunized with ... a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof." Moreover, Ackerman and Nakamura together fail to provide any suggestion or motivation to provide such an antibody, nor does the combination of these references provide any reasonable expectation of success.

Accordingly, for these reasons at least, applicants respectfully submit that the rejection under 35 U.S.C. §103(a) over Spencer, Ackerman and Nakamura is

overcome.

The Claim Rejections Under 35 U.S.C. §103(a) over Database SPTREMBL, Ackerman and Nakamura

Claims 16-18 and 24 stand rejected under 35 U.S.C. §103(a) as allegedly being obvious over Database SPTREMBL 23 Accession NO. P978144 (01 May 1997) in view of Ackerman and Nakamura.

The SPTREMBL reference cited against Claim 24 is dated May 1, 1997, which, as discussed above, is after the priority date of February 7, 1997 of the instant application. For at least this reason, SPTREMBL is not a proper reference against the present application.

Ackerman is presented as teaching that monoclonal antibodies are widely used, and Nakamura is presented as suggesting that monoclonal antibodies may be useful in characterizing the expression of a polypeptide and in quantifying and purifying the polypeptide to which the antibody binds. However, as discussed above, Ackerman and Nakamura each lack at least the claim element of an antibody derivable from a lymphocyte from an animal that has been immunized with a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof. The combination of these references does not make up for this lack.

Ackerman and Nakamura together provide no suggestion or motivation to provide an antibody derivable from a lymphocyte from an animal that has been immunized with a PSTPIP polypeptide of SEQ ID NO:1 or a fragment thereof. Thus, the combination of these references also lacks at least this element required by the present claims. In addition, Ackerman and Nakamura fail to provide any suggestion or motivation to provide these elements of the present claims, nor do they provide any reasonable expectation of success for such a combination.

Accordingly, for these reasons at least, the rejection of Claims 16-18 and 24 under 35 U.S.C. §103(a) over SPTREMBL, Ackerman and Nakamura is overcome.

CONCLUSION

Applicants believe all rejections to be overcome as discussed above, and request the entry of the amendments, which are believed to place the claims in condition for allowance and in better form for appeal. Reconsideration and allowance of all pending claims is respectfully requested. All claims being believed to be in *prima facie* condition for allowance, an early action to that effect is respectfully solicited.

Please charge any additional fees, including any fees for extension of time, or credit overpayment to Deposit Account No. **08-1641**, referencing Attorney's Docket No. **39766-0061 CP2**.

Respectfully submitted,

Date: September 3, 2004

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